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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/820,118	04/08/2004	Masato Yoshioka	4244-0104PUS1	8645

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EXAMINER

LANDAU, SHARMILA GOLLAMUDI

ART UNIT	PAPER NUMBER
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1616

SHORTENED STATUTORY PERIOD OF RESPONSE	NOTIFICATION DATE	DELIVERY MODE
3 MONTHS	04/20/2007	ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

Notice of this Office communication was sent electronically on the above-indicated "Notification Date" and has a shortened statutory period for reply of 3 MONTHS from 04/20/2007.

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mailroom@bskb.com

Office Action Summary	Application No. 10/820,118	Applicant(s) YOSHIOKA ET AL.	
	Examiner Sharmila S. Gollamudi	Art Unit 1616	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 08 April 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-4 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-4 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Preliminary Amendment to the Specification filed 4/8/04, Foreign Priority Papers filed 6/16/04, and the Information Disclosure Statement filed 12/11/06 is acknowledged. Claims 1-4 are pending in this application.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1-4 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 1 is directed to a composition “comprising a silylated peptide-silane compound copolymer composition which is produced by the following process and has a viscosity in a range from 500 to 20000 mPas....” The claim is vague and indefinite since it is unclear if the viscosity is referring to the viscosity of the composition or the copolymer. For the purposes of applying prior art, the examiner will interpret the claim to be directed to the copolymer having a viscosity of 500 to 20000 mPas.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

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Claims 1-4 are rejected under 35 U.S.C. 102(b) as being anticipated by Yoshioka et al (6,228,968) or EP 0934966 to Yoshioka et al. Note that both documents have the same disclosure and thus the examiner will refer to US '968 disclosure.

Yoshioka et al disclose a silylated peptide copolymer made of general formula (I), general formula (II), and general formula (III). See abstract and column 2, line 50 to column 3, line 50. Yoshioka discloses the silylated peptide copolymer increases moisture-retaining properties of a cosmetic and thus provides moisturization, luster, and a smooth feel to the skin or hair. See column 12, lines 25-26 and lines 52-65. Yoshioka discloses mixing the silylated peptide copolymer with shampoo to provide a foam that generates a soft feeling. See column 12, line 59. Example 12 discloses mixing 10% of the silylated peptide copolymer in an aqueous solution to treat hair. Note examples for molar ratio.

Regarding the preamble recited in claims 3-4, i.e. a hair coloring agent, it should be noted that a preamble is generally not accorded any patentable weight where it merely recites the purpose of a process or the intended use of a structure, and where the body of the claim does not depend on the preamble for completeness but, instead, the process steps or structural limitations are able to stand alone. See *In re Hirao*, 535 F.2d 67, 190 USPQ 15 (CCPA 1976) and *Kropa v. Robie*, 187 F.2d 150, 152, 88 USPQ 478, 481 (CCPA 1951). In instant case, the body of the claim is not structurally distinguishable from the prior art and therefore the prior art anticipates the claims.

Regarding the product-by-process limitation, note MPEP section 2113, "even though product by process claims are limited by and defined by the process, determination of patentability is based on the product itself. The patentability of a product does not depend on its

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method of production, if the product in the product-by-process claim is the same or obvious from a product of the prior art, the claim is unpatentable even though the prior art was made by a different process.” *In re Thorpe*, 777 F.2d 695, 698, 227 USPQ 964, 966 (Fed.Cir. 1985).

With regard to the viscosity, it is the examiner’s position that the prior art’s silylated peptide copolymer made of general formula (I), general formula (II), and general formula (III) has the same viscosity claimed since the prior art’ copolymer and instant copolymer are not structurally distinguishable. “Products of identical chemical composition can not have mutually exclusive properties.” See *In re Spada*, 911 F.2d 705, 709, 15 USPQ2d 1655, 1658 (Fed. Cir. 1990).

Claims 1-4 are rejected under 35 U.S.C. 102(b) as being anticipated by Yoshioka et al JP 2001-048775 (partial computer translation).

Yoshioka et al disclose a silylated peptide copolymer made of general formula (I), general formula (II), and general formula (III). See [0012]-[0017], [0022]-[0023], [0035]. Yoshioka discloses the silylated peptide copolymer for formulating hair cosmetics, milky lotions, hair rinses, hair conditioners, shampoos, hair setting agents, etc. [0042]. Yoshioka discloses using 0.05-20% of the silylated peptide copolymer in the cosmetic formulation. [0044] Other agents including anionic surface active agents, cationic polymers, pigments, etc. [0045]. Note examples for molar ratio.

Regarding the product-by-process limitation, note MPEP section 2113, “even though product by process claims are limited by and defined by the process, determination of patentability is based on the product itself. The patentability of a product does not depend on its method of production, if the product in the product-by-process claim is the same or obvious

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from a product of the prior art, the claim is unpatentable even though the prior art was made by a different process.” *In re Thorpe*, 777 F.2d 695, 698, 227 USPQ 964, 966 (Fed.Cir. 1985).

With regard to the viscosity, it is the examiner’s position that the prior art’s silylated peptide copolymer made of general formula (I), general formula (II), and general formula (III) has the same viscosity claimed since the prior art’ copolymer and instant copolymer are not structurally distinguishable. “Products of identical chemical composition can not have mutually exclusive properties.” See *In re Spada*, 911 F.2d 705, 709, 15 USPQ2d 1655, 1658 (Fed. Cir. 1990).

Double Patenting

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the “right to exclude” granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 1-4 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims of copending Application No. 10/841518.

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Although the conflicting claims are not identical, they are not patentably distinct from each other because:

The instant application is directed to a hair treatment agent, shampoo, or a hair coloring agent comprising a silylated peptide-silane compound copolymer composition which is produced by the following process and has a viscosity in a range from 500 to 20000 mPas in 70% of solid content concentration of said copolymer composition at 20.degree. C., wherein said process comprises: polycondensing one or more kind selected from silylated peptides represented by the general formula (I) with one or more kind selected from silane compounds represented by the general formula (II) in an aqueous solution in a range of reaction molar ratio of said silylated peptide to said silane compound from 1:1 to 1:100 to form a polycondensed polymer, and then adding by addition reaction a silane compound represented by the general formula (III) in an aqueous solution to said polycondensed polymer; wherein said silylated peptide represented by the following general formula (I) is 3, in which R^{sup.1} represents a hydroxy group or an alkyl group having 1 to 3 carbon atoms, R^{sup.2} represents a residual group of a side chain obtained by removing the terminal end amino group of a basic amino acid having an amino group at the end of a side chain, R^{sup.3} represents a side chain of an amino acid other than R^{sup.2}, A is a connecting moiety and represents at least one group selected from the group consisting of --CH₂--, --(CH₂)₃--, --(CH₂)₃OCH₂CH(OH)CH₂--, --(CH₂)₃S-- , --(CH₂)₃NH-- and --(CH₂)₃OCOCH₂CH₂--, and x is from 0 to 50, y is from 1 to 100 and x+y is from 1 to 100, wherein x and y represent only the number of amino acid units and do not represent the order of amino acid sequence; wherein said silane compound represented by the following general formula (II) is R^{sup.4}mSi(OH)_pY(4-

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p-m) (II) , in which m represents an integer from 0 to 2, p represents an integer from 2 to 4, m+p is not more than 4, R.sup.4 represents an organic group in which a carbon atom is directly connected to the silicon atom and R.sup.4s of may be the same or different, and Ys of (4-p-m) represent an alkoxy group or hydrogen atom; and wherein silane compound represented by the following general formula (III) is R.sup.5.sub.3Si(OH) (III) , wherein three R.sup.5s represent organic groups in which a carbon atom is directly connected to the silicon atom and three R.sup.5s may be the same or different. Dependent claims are directed to the silylated peptide-silane compound copolymer comprising 0.01-5 and 0.05-10%.

Copending application is directed to a makeup cosmetic comprising a silylated peptide-silane compound copolymer composition which is produced by the following process and has viscosity in a range from 500 to 30000 mPa.s in 70% of solid content concentration of said copolymer composition at 20.degree. C. wherein said process comprises: polycondensing one or more kind selected from silylated peptides represented by the general formula (I) with one or more kind selected from silane compounds represented by the general formula (II) in an aqueous solution in a range of reaction molar ratio of said silylated peptide to said silane compound from 1:1 to 1:100 to form a polycondensed polymer, and then adding by addition reaction a silane compound represented by the general formula (III) in an aqueous solution to said polycondensed polymer; wherein said silylated peptide represented by the following general formula (I) is 3, in which R.sup.1 represents a hydroxy group or an alkyl group having 1 to 3 carbon atoms, R.sup.2 represents a residual group of a side chain obtained by removing the terminal end amino group of a basic amino acid having an amino group at the end of a side chain, R.sup.3 represents a side chain of an amino acid other than R.sup.2, A is a connecting moiety and represents at least one

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group selected from the group consisting of --CH.sub.2--, --(CH.sub.2).sub.3--, --(CH.sub.2).sub.3OCH.sub.2CH(OH)CH.sub.2--, --(CH.sub.2).sub.3S--, --(CH.sub.2).sub.3NH-- and --(CH.sub.2).sub.3OCOCH-.sub.2CH.sub.2--, and x is from 0 to 50, y is from 1 to 100 and x+y is from 1 to 100, wherein x and y represent only the number of amino acid units and do not represent the order of amino acid sequence; wherein said silane compound represented by the following general formula (II) is $R^{sup.4}mSi(OH)_pY_{(4-p-m)}$ (II), in which m represents an integer from 0 to 2, p represents an integer from 2 to 4, m+p is not more than 4, $R^{sup.4}$ represents an organic group in which a carbon atom is directly connected to the silicon atom and $R^{sup.4}$ s of m may be the same or different, and Ys of (4-p-m) represent an alkoxy group or hydrogen atom; and wherein silane compound represented by the following general formula (III) is $R^{sup.5}.sub.3Si(OH)$ (III) wherein three $R^{sup.5}$ s represent organic groups in which a carbon atom is directly connected to the silicon atom and three $R^{sup.5}$ s may be the same or different.

Dependent claims are directed to the silylated peptide-silane compound copolymer comprising 0.5 to 80% by weight (claim 2) and 0.05-10% (claim 10).

The instant application and copending application are directed to similar subject matter since both claim a composition comprising the same the silylated peptide-silane compound copolymer. Although the preambles are different, it is pointed out that the preamble and the intended use recitations of the instant claims and those of the above co-pending product claims are not afforded patentable weight. A preamble is generally not accorded any patentable weight where it merely recites the purpose of a process or the intended use of a structure, and where the body of the claim does not depend on the preamble for completeness but, instead, the process steps or structural limitations are able to stand alone. See *In re Hirao*, 535 F.2d 67, 190 USPQ 15

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(CCPA 1976) and *Kropa v. Robie*, 187 F.2d 150, 152, 88 USPQ 478, 481 (CCPA 1951). In instant case, the same composition is claimed without a structural difference.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

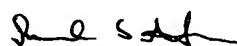
Conclusion

All the claims are rejected.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Sharmila S. Gollamudi whose telephone number is 571-272-0614. The examiner can normally be reached on M-F (8:00-5:30), alternate Fridays off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Johann Richter can be reached on 571-272-0646. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



Sharmila S. Gollamudi
Primary Examiner
Art Unit 1616